

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XU PEICHENG (HONG KONG) OPTOELECTRONIC
TECHNOLOGY CO., LIMITED,
Petitioner,

v.

SEMISILICON TECHNOLOGY CORP.,
Patent Owner.

IPR2024-00157
Patent 8,124,988 B2

Before CHARLES J. BOUDREAU, SHEILA F. McSHANE, and
ELIZABETH J. REAGAN, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Xu Peicheng (Hong Kong) Optoelectronic Technology Co., Limited (“Petitioner”) requests rehearing of the Board’s May 20, 2024, Decision Denying Institution of *Inter Partes* Review (Paper 9, “Dec.”) of U.S. Patent No. 8,124,988 B2 (Ex. 1001, “the ’988 patent”) in the above-captioned matter. Paper 11 (“Request for Rehearing” or “Req. Reh’g”). For the reasons set forth below, Petitioner’s Request for Rehearing is *denied*.

II. BACKGROUND

On November 8, 2023, Petitioner filed a Petition requesting *inter partes* review of claims 1–17, 20, and 21 (“the challenged claims”) of the ’988 patent. Paper 1 (“Pet.”). In the Petition, Petitioner asserted a total of seven grounds of unpatentability, including, as relevant to the Request for Rehearing, that claims 1–3, 5–10, 13, and 14 of the ’988 patent are unpatentable over Lai (CN 201017882Y) in view of the general knowledge of a person of ordinary skill in the art (“POSITA”); that claims 4, 11, and 12 are unpatentable over Lai in combination with Stoyan (US 2008/0087903 A1) in further view of the general knowledge of a POSITA; and that claim 15 is unpatentable over Lai in view of Yan (US 7,473,933 B2) (collectively, the “Lai-based grounds”).¹ Pet. 5–34, 95–97. Semisilicon Technology Corp. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Following consideration of the arguments and evidence presented in the Petition and the Preliminary Response, we concluded that Petitioner did

¹ Petitioner’s Request for Rehearing does not allege error in our determinations with respect to the four remaining grounds not based on Lai, and we do not revisit our analysis with respect to those grounds in this Decision.

not demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims, and we denied the Petition and declined to institute an *inter partes* review. Dec. 11–55. With respect to the Lai-based grounds in particular, we explained that “the Petition effectively concedes that there is a structural difference between pins, as disclosed by Lai, and pads, as recited in claim 1 [of the ’988 patent], and Petitioner does not reconcile this difference or explain why a person of ordinary skill in the art would have been motivated to modify Lai’s disclosure and use pads rather than the pins Lai discloses.” *Id.* at 19. We also explained that the “Petitioner has not persuasively shown that a person of ordinary skill in the art would regard pins and pads as interchangeable or that pads would otherwise be suggested by Lai’s disclosure of pins.” *Id.* Further, because claims 2–15 depend directly or indirectly from claim 1 and Petitioner did not cite Stoyan or Yan as teaching or suggesting the subject matter of independent claim 1 that we found lacking from Petitioner’s allegations with respect to Lai and the general knowledge of a person of ordinary skill in the art, we additionally concluded that Petitioner did not demonstrate a reasonable likelihood it would succeed in its various challenges to claims 2–15 on the Lai-based grounds. *Id.* at 22–25.

III. ANALYSIS

A party requesting rehearing bears the burden of showing that the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.”

37 C.F.R. § 42.71(d). When considering a request for rehearing of a decision whether to institute an *inter partes* review, the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision [i]s based on an erroneous conclusion of

law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). A request for rehearing is not an opportunity merely to disagree with the panel’s assessment of the arguments or weighing of the evidence. “It is not an abuse of discretion to have made an analysis or conclusion with which a party disagrees,” and “mere disagreement with the Board’s analysis or conclusion is not a proper basis for rehearing.” *EMC Corp. v. PersonalWeb Techs., LLC*, IPR2013-00085, Paper 29 at 4 (PTAB June 5, 2013) (Decision Denying Patent Owner’s Request for Rehearing).

In the Request for Rehearing, referring to a pending *ex parte* reexamination proceeding in which the USPTO Central Reexamination Unit (“CRU”) found that Lai presents a substantial new question (“SNQ”) of patentability with respect to claims 1–3, 5–12, 23, and 24 of the ’988 patent, Petitioner contends, first, that “[b]ecause the USPTO already considered this Petition and found that Lai ‘reasonably teaches a LED light package where a 1st conductor is a positive DC voltage pad,’ the Board abused its discretion when it decided not to institute this proceeding.” Req. Reh’g 2–3 (citing Ex. 1014, 3, 6, 9, 13–14 (Order granting request for reexamination); *Vicor Corp. v. SynQor, Inc.*, 869 F.3d 1309, 1321–22 (Fed. Cir. 2017)).

We disagree with Petitioner. Notwithstanding Petitioner’s argument that “the USPTO already considered *this Petition* and found that Lai ‘reasonably teaches a LED light package where a 1st conductor is a positive DC voltage pad’” (Req. Reh’g 3 (emphasis added)), the Order granting the request for reexamination does not indicate that the CRU substantively considered the merits of Petitioner’s contentions in this case in determining that Lai presents an SNQ with respect to the claims subject to reexamination. To the extent the present proceeding is referenced at all in the CRU’s Order,

it is in connection with the CRU's determination that, despite Lai being asserted both in certain grounds in the Petition and in several of the potential SNQs alleged in the reexamination request filed by third-party Brightek Optoelectronics Co., Ltd., the Petition was filed after the *ex parte* reexamination request and therefore does not implicate considerations under 35 U.S.C. § 325(d). *See* Ex. 1014, 4, 12–15. And while the CRU's Order notes in that discussion that the first ground in the Petition “bolsters the teachings disclosed in Lai with that of the general knowledge of a POSITA,” including specifically mentioning that the “Ground #1 [of the Petition] bolsters SNQ Ground #1's allegation that Lai's VDD DC voltage pad [sic] is a ‘pad’ because POSITA would understand it as such,” the Order does not comment on the persuasiveness of the Petition's arguments. *See id.* at 13–14.²

Importantly, the determination whether to order a reexamination is subject to a different statutory standard than the Board's determination whether to institute an *inter partes* review. *Compare* 35 U.S.C. § 303(a) (“[T]he Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On [their] own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by [them] or cited under the provisions of section 301 or 302.”) *and id.* § 304 (“If, in a determination made under the provisions of subsection 303(a), the Director finds that a substantial new

² “SNQ Ground #1” refers to alleged anticipation by Lai of claims 1–3, 5–12, 23, and 24 of the '988 patent. *See* Ex. 1014, 5.

question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question.”), *with id.* § 314(a) (“The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”). Thus, for example, whereas the statutory framework with respect to reexamination proceedings expressly permits the Office to go beyond the four corners of a reexamination request and bring in additional evidence or even to initiate reexamination *sua sponte*,³ we are constrained here by the information presented in the Petition and Preliminary Response.⁴ There is no provision in the law or regulations that requires—or even permits—the Board to defer to the CRU’s determination on a new question of patentability in place of its

³ See 35 U.S.C. § 303(a); *see also* Manual of Patent Examining Procedure § 2244 (9th ed. rev. 07.2022 Feb. 2023) (“The determination under 35 U.S.C. 303(a) whether or not ‘a substantial new question of patentability’ is present can be based upon any prior art patents or printed publications. . . . The examiner is not limited in making the determination based on the patents and printed publications relied on in the request. The examiner can find ‘a substantial new question of patentability’ based upon the prior art patents or printed publications relied on in the request, a combination of the prior art relied on in the request and other prior art found elsewhere, or based entirely on different patents or printed publications.”).

⁴ Notably, the Preliminary Response in this proceeding was filed on February 22, 2024, one week after the February 15, 2024, mailing date of the CRU’s Order (*see* Ex. 1014, 1), and we find no evidence in the record that the CRU had the benefit of any response from Patent Owner at the time as of the Order’s mailing date. We will not speculate as to whether such information would have affected the CRU’s determination.

own judgment in deciding whether to institute an *inter partes* review. And, therefore, it is not an abuse of discretion to deny institution, even though a reexamination of the same patent was initiated.

Petitioner's reliance on *Vicor* is misplaced, because that case dealt with inconsistent Board decisions, *both in appeals from reexamination proceedings*, where, "without any explanation to justify such inconsistency," the Board "weighed the same evidence differently and reached different outcomes in its decisions for . . . two related patents." *Vicor*, 869 F.3d at 1319, 1321. We distinguish the present situation, involving different types of proceedings that are, as explained above, subject to different statutory frameworks and evidentiary thresholds.

To the extent that Petitioner contends we should agree with the *reasoning* of the Central Reexamination Unit and institute a trial based on the Petition over similar grounds, this is essentially a disagreement with the reasoning behind our decision to deny institution. However, it is not an abuse of discretion to have made an analysis or conclusion with which a party disagrees.

Petitioner also contends, specifically as to limitations 1[E] and 1[H] in the ground over Lai, that "the Board abused its discretion by failing to properly consider [Dr. Schubert's opinion] despite Patent Owner failing to submit opposing expert testimony." Req. Reh'g 7; *see also id.* at 9 ("Dr. Schubert's opinions are wholly supported by underlying facts borne from the common knowledge of a POSITA and therefore it is abuse of discretion to discredit them.").

We again disagree. Claim 1 is drawn to an "LED lamp package structure," where limitation 1[E] recites a "first conductor being a positive DC voltage pad" and limitation 1[H] recites a "fourth conductor being a

negative DC voltage pad.” Thus, claim 1 recites “pad[s],” not “pins” or “terminals.” In the Petition, Petitioner alleged that “a POSITA would have understood the terms ‘pad’ and ‘pin’ to both refer to a terminal which connects a device to a mounting substrate” and that “‘pad’ and ‘pin’ are implementations of a terminal, with both serving the same function.”

Pet. 12. Petitioner further cited Exhibit 1012 for a dictionary definition of “pad,” and Exhibit 1013 for a dictionary definition of “pin.” *Id.*

Dr. Schubert’s Declaration repeats the same assertions and citations.

Ex. 1003 ¶ 44. The cited definitions—which are the only evidence cited by Dr. Schubert on this point—show how pads and pins are *different* from each other (*see* Exs. 1012, 1013). Thus, contrary to Petitioner’s assertion that “Dr. Schubert’s opinions are wholly supported by underlying facts” (Req. Reh’g 9), the cited evidence instead undermines Dr. Schubert’s opinion with respect to the recited “DC voltage pad[s].” As we explained in the Decision Denying Institution,

the Petition effectively concedes that there is a structural difference between pins, as disclosed by Lai, and pads, as recited in claim 1, and Petitioner does not reconcile this difference or explain why a person of ordinary skill in the art would have been motivated to modify Lai’s disclosure and use pads rather than the pins Lai discloses. Even if pins and pads may both be types of terminals, claim 1 specifically recites pads, not terminals, and Petitioner has not persuasively shown that a person of ordinary skill in the art would regard pins and pads as interchangeable or that pads would otherwise be suggested by Lai’s disclosure of pins.

Dec. 19 (citation omitted).

IV. CONCLUSION

We have considered each of Petitioner’s arguments in its Request for Rehearing but are not persuaded that we misapprehended or overlooked any

matter in our Decision Denying Institution of *Inter Partes* Review or that any allegedly misapprehended or overlooked matters amounted to an abuse of discretion.

V. ORDER

Accordingly, it is hereby

ORDERED that the Request for Rehearing is *denied*.

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